

## **REMARKS**

The Non-Final Office Action mailed February 11, 2008, has been received and reviewed. As of the February 11, 2008 Office Action, Claims 1-31 were pending and presently stand rejected. Additionally, the Examiner has objected to Claims 11-12. Applicant has amended Claims 1, 8, 11-12, 22, 25 and 29. Applicant has cancelled Claims 5, 14 and 26. As of this Amendment A, Claims 1-4, 6-13, 15-25 and 27-31 are believed to be in condition for allowance and Applicant respectfully requests reconsideration of the application as amended herein.

### **Claim Objections**

The Examiner has objected to Applicant's use of trademark symbols in Claims 11-12. Applicant has amended Claims 11-12 to correct for proper use of trademark symbols.

### **35 U.S.C. § 112, ¶ 2 Indefiniteness Rejections**

The Examiner has rejected Claims 1-12, 22, 25 and 29-31 under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner asserts that the term "optionally" renders Claims 1-12, 8 and 29-31 indefinite. The Examiner further asserts that the term "the computer" in Claim 22 lacks proper antecedent basis. Similarly, the Examiner asserts that the term "the plurality of printers" in Claim 25 also lacks proper antecedent basis.

Accordingly, Applicant has amended Claims 1, 6, 8 and 29 to remove the term "optionally". Applicant has also amended Claims 22 and 25 to cure the errors in antecedent basis noted by the Examiner. Applicant has further amended Claim 24 to cure an error in antecedent basis and Claim 4 to correct an error in antecedent basis or dependency. Claim 5 has been cancelled.

Applicant believes that Claims 1-12, 22, 25 and 29-31, as amended, are definite and respectfully requests reconsideration of the indefiniteness rejections.

### 35 U.S.C. § 102(b) Anticipation Rejections

The standard for anticipation as set forth by the Court of Appeals for the Federal Circuit is as follows:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

#### Anticipation Rejection Based on U.S. Published Patent Application No. 2003/0106020 to Silverbrook et al.

Claims 1-4, 6-7, 10, 13, 15-16, 21-23, 25 and 29-31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Silverbrook et al. Applicant has amended Claim 1 to clarify that “each note includes visually perceptible note information and a ***duplicate*** computer readable symbology of the note information” as recited in amended Claim 1, added amendment emphasized. This feature is distinguishable from the “netpage” or “whiteboard” and associated “tags” disclosed in Silverbrook et al. Applicant has amended Claim 1 to recited: “printing the notes ***on Post-It® note media***”, added limitation emphasized. Silverbrook et al. makes no mention of printing on Post-It® note media. Finally, Applicant has further amended Claim 1 to emphasize that the discrete portions of information are captured by a computer keyboard rather than the netpage pen and whiteboard of Silverbrook et al. More specifically, amended Claim 1 recites “capturing discrete portions of information ***with a computer keyboard***”, added limitation emphasized.

As disclosed in Silverbrook et al., “[a] netpage consists of a printed page (or other surface region) invisibly tagged with references to an online description of the page. The online page description is maintained persistently by a netpage page server. The page description describes the visible layout and content of the page, including text, graphics and images. It also describes the input elements on the page, including buttons, hyperlinks, and input fields. A netpage allows markings made with a netpage pen on its surface to be simultaneously captured and processed by the netpage system.” ¶ [0080]. “Each reference to the page description is encoded in a printed tag.

The tag identifies the unique page on which it appears, and thereby indirectly identifies the page description. The tag also identifies its own position on the page.” ¶ [0082]. A “tag may also contain flags which relate to the region as a whole or to the tag. One or more flag bits may, for example, signal a tag sensing device to provide feedback indicative of a function associated with the immediate area of the tag, without the sensing device having to refer to a description of the region. A netpage pen may, for example, illuminate an ‘active area’ LED when in the zone of a hyperlink.” ¶ [0087].

As disclosed in Silverbrook et al., “[a] tag is sensed by an area image sensor in the netpage pen, and the tag data is transmitted to the netpage system via the nearest netpage printer. The pen is wireless and communicates with the netpage printer via a short-range radio link.” ¶ [0084]. As further stated in Silverbrook et al., “the tags function in cooperation with associated visual elements on the netpage as user interactive elements in that a user can interact with the printed page using an appropriate sensing device in order for tag data to be read by the sensing device and for an appropriate response to be generated in the netpage system.” ¶ [0105].

From the above description of “netpages”, “page descriptions” and “tags” disclosed in Silverbrook et al., it is apparent that a netpage may include “visually perceptible note information”. It is further apparent that a netpage may include “computer readable symbology”, namely a tag. However, the tag, itself, is not a duplicate of the visually perceptible note information. Rather, the tag simply includes “16 bits of tag ID, at least 90 bits of region ID, and a number of flag bits.” ¶ [0090]. In other words, the tag includes a reference to a page description (tag ID), a page location identifier (region ID) and optional actions or interactions based on flags (flag bits). Thus, the tag as described in Silverbrook et al. does not include “a duplicate computer readable symbology of the note information” as recited in amended Claim 1. Silverbrook et al. is silent as to printing the notes on Post-It® note media. Additionally, the note information is captured using a keyboard rather than the netpage pen and whiteboard of Silverbrook et al.

For all of these reasons, amended Claim 1 is believed to be novel over Silverbrook et al. Claim 5 has been cancelled herein. Claims 2-4 and 6-12 depend

from amended Claim 1 and are, thus, believed to be novel over Silverbrook et al. for the same reasons as Claim 1.

Applicant has amended Claim 13 to further clarify the invention recited therein. More particularly, amended Claim 13 recites the limitation: "wherein each output includes a visually perceptible version of each discrete portion of the information and a **duplicate** computer readable symbology of each discrete portion of the information", emphasis on added limitation. As discussed above with reference to amended Claim 1, Silverbrook et al. fails to disclose "a **duplicate** computer readable symbology of the note information."

Claim 13 has further been amended to include the limitation "a computer keyboard" and also recites "receiving discrete portions of information using the computer keyboard". The input device of Silverbrook et al. is a netpage pen, rather than the computer keyboard now recited in amended Claim 13.

For these reasons, amended Claim 13 is believed to be novel over Silverbrook et al. Claim 14 has been cancelled herein. Claims 15-24 depend from amended Claim 13 and are, thus, believed to be novel over Silverbrook et al. for the same reasons as Claim 13.

Applicant has amended Claim 25 to further clarify the invention recited therein. More particularly, amended Claim 25 recites the limitation: "an output comprising the information and a **duplicate** computer readable symbology of the information", emphasis on the added limitation. As discussed above with reference to amended Claims 1 and 13 above, Silverbrook et al. fails to disclose "a **duplicate** computer readable symbology of the information" as recited in amended Claim 25. Claim 25 has further been amended to recite the limitation: "wherein the output is configured for printing notes on **Post-It® note** media", added limitation emphasized. Silverbrook et al. does not disclose printing directly to Post-It® note media.

For this reason, amended Claim 25 is believed to be novel over Silverbrook et al. Claim 26 has been cancelled. Claim 27 has been amended to conform with the amendment to Claim 25. Claims 27-28 depend from amended Claim 25 and are, thus, believed to be novel over Silverbrook et al. for the same reasons as amended Claim 25.

Applicant has amended Claim 29 to further clarify the invention recited therein. More particularly, amended Claim 29 recites the limitation: "wherein each note includes a visually perceptible version of the discrete portion of information and a **duplicate** computer readable symbology of the discrete portion of the information", emphasis on the added limitation. As discussed above with reference to amended Claims 1, 13 and 25 above, Silverbrook et al. fails to disclose "a **duplicate** computer readable symbology of the discrete portion of the information" as recited in amended Claim 29. Applicant has also amended Claim 29 to recite the limitation: "printing the notes on a printer **using Post-It® note media**", added limitation emphasized. Silverbrook et al. does not disclose printing directly to Post-It® note media.

For these reasons, amended Claim 29 is believed to be novel over Silverbrook et al. Claims 30-31 depend from amended Claim 29 and are, thus, believed to be novel over Silverbrook et al. for the same reasons as amended Claim 29.

In view of the amendments and supporting arguments above, Applicant respectfully requests reconsideration of the anticipation rejection of Claims 1-4, 6-7, 10, 13, 15-16, 21-23, 25 and 29-31 based on Silverbrook et al.

### **35 U.S.C. § 103(a) Obviousness Rejections**

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, reaffirmed the objective analysis for determining obviousness under 35 U.S.C. § 103: "[T]he scope and content of the prior art are . . . determined; differences between the prior art and the claims at issue are . . . ascertained; and the level of ordinary skill in the pertinent art resolved." 127 S.Ct. 1727, 1729-30, (U.S. 2007) (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)).

M.P.E.P. 706.02(j) sets forth the contents of a Section 103(a) rejection:

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

*Ex parte Clap*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

Obviousness Rejection Based on U.S. Published Patent Application No. 2003/0106020 to Silverbrook et al. in view of Coldiron, "Colorflex does on-demand, custom-labeling

systems", Boulder County Business Report, Boulder: Nov 15, 2002, Vol. 21, Iss. 24, p. A11

The Examiner has rejected Claims 5, 17, 19, 20, 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook et al. in view of Coldiron. The Examiner asserts that Silverbrook et al. disclose the limitations of original Claims 1, 13 and 25. However, as noted above, Applicant has amended independent Claims 1, 13 and 25 and believes that Silverbrook et al. now fails to anticipate amended Claims 1 and 13. Applicant has cancelled Claims 5 and 26.

As noted above, Claims 17, 19-20 and 24 depend from amended Claim 13. Neither Silverbrook et al. nor Coldiron discloses or suggests all of the limitations in amended Claims 1, 13 and 25. Because of the amendments to independent Claims 1, 13 and 25, Applicant asserts that Claims 17, 19, 20 and 24 are nonobvious over the asserted combination of Silverbrook et al. in view of Coldiron.

Applicant has amended Claim 17 to recite the limitation: wherein the output comprises a *printed Post-It® note*", added limitation emphasized. As the Examiner notes, Coldiron discloses printing color-coded labels with bar codes, electronic tracking software and barcoding to link paper and electronic records, Coldiron is silent as to printing on a Post-It® note, as recited in amended Claim 17. For this reason, amended Claim 17 is independently nonobvious over the asserted combination of Silverbrook et al. in view of Coldiron.

For all of these reasons, Applicant respectfully requests reconsideration of the obviousness rejection based on Silverbrook et al. in view of Coldiron.

Obviousness Rejection Based on U.S. Published Patent Application No. 2003/0106020 to Silverbrook et al. in view of Jessup, "A quantum formula for improving meetings", The Journal for Quality and Participation, Cincinnati: Jun. 1994, Vol. 17, Iss. 3; p. 80

The Examiner has rejected Claims 8-9 and 27-28 under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook et al. in view of Jessup. The Examiner asserts that Silverbrook et al. disclose the limitations of original Claims 1 and 25. However, as noted above, Applicant has amended Claims 1 and 25 and believes that Silverbrook et al. now fails to anticipate amended Claims 1 and 25.

As noted above, Claims 8-9 depend from amended Claim 1 and Claims 27-28 depend from amended Claim 25. Neither Silverbrook et al. nor Jessup discloses or suggests all of the limitations in amended Claims 1 and 25.

Because of the amendments to independent Claims 1, 13 and 25, Applicant asserts that Claims 8-9 and 27-28 are nonobvious over the asserted combination of Silverbrook et al. in view of Jessup. Applicant respectfully requests reconsideration of the obviousness rejection based on Silverbrook et al. in view of Jessup.

Obviousness Rejection Based on U.S. Published Patent Application No. 2003/0106020 to Silverbrook et al.

Claims 11-12 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook et al. As noted above, Applicant has amended Claim 1 and believes that Silverbrook et al. now fails to anticipate amended Claim 1. Claim 14 has been cancelled herein

Further as noted above, Claims 11-12 depend from amended Claim 1. As argued above, Silverbrook et al. fails to disclose or suggest all of the limitations in amended Claims 1.

Because of the amendments to independent Claim 1, Applicant asserts that Claims 11-12 are nonobvious over Silverbrook et al. Applicant respectfully requests reconsideration of the obviousness rejection based on Silverbrook et al.

Obviousness Rejection Based on U.S. Published Patent Application No. 2003/0106020 to Silverbrook et al. in view of Coldiron, "Colorflex does on-demand, custom-labeling systems", Boulder County Business Report, Boulder: Nov 15, 2002, Vol. 21, Iss. 24, p. A11 further in view of Jessup, "A quantum formula for improving meetings", The Journal for Quality and Participation, Cincinnati: Jun. 1994, Vol. 17, Iss. 3; p. 80

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook et al. in view of Coldiron in further view of Jessup. As noted above, Applicant has amended Claim 13 and believes that Silverbrook et al. now fails to anticipate amended Claim 13.

Further as noted above, Claim 18 depends from amended Claim 13. As argued above, Silverbrook et al. fails to disclose or suggest all of the limitations in amended Claim 13. Neither Coldiron nor Jessup remedies this lack of disclosure.

Because of the amendments to independent Claim 13, Applicant asserts that Claim 18 is nonobvious over Silverbrook et al. in view of Coldiron in further view of Jessup. Applicant respectfully requests reconsideration of the obviousness rejection based on Silverbrook et al. in view of Coldiron in further view of Jessup.

### CONCLUSION

Claims 1-4, 6-13, 15-25 and 27-31 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0881.

Respectfully Submitted,



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